

AMENDMENT UNDER 37 C.F.R. § 1.111

Appln. No.: 09/611,308

**REMARKS**

Claims 1-23 are all the claims pending in the application.

The Examiner rejects:

- claims 1-3, 13, 19-22 and 23 under 35 U.S.C. §103(a) as being unpatentable over Shoji;
- claim 9 under 35 U.S.C. §103(a) as being unpatentable over Shoji in view of Popovic; and
- claim 11 under 35 U.S.C. §103(a) as being unpatentable over Shoji in view of Terashima.

Also, the Examiner objects to claims 2-4, 7, 8 and 11-23 due to minor informalities.

The Examiner indicates that claims 4-8, 10, 12 and 14-18 would be **allowable** if rewritten in independent form including all of the limitations of the base claim and any intervening claims and amended to overcome the Examiner's claim objections.

As a formal matter, Applicant respectfully requests the Examiner to acknowledge receipt of, and approve, the formal drawings filed on May 28, 2002.

With regard to Examiner's claim objections, Applicant amends the claims as suggested by the Examiner (see Office Action, paragraph 1) and to correct minor informalities not noted by the Examiner. These amendments simply address minor informalities and do not narrow the scope of the original claims. No estoppel is created. Applicant notes that claims 14-18 are now in condition for immediate allowance.

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With regard to the Examiner's prior art rejections, Applicant respectfully traverses these rejections as follows.

Applicant's claimed invention provides a radio communication apparatus comprising unique a combination of features including, *inter alia*:

at least one delay profile circuit, which generates the delay profile by calculating correlation between a reception signal and known data at a plurality of timings, and a timing circuit for generating a correlation timing in the delay profile circuit, such that the operation of the delay profile circuit and the timing circuit is stopped in accordance with a correlation value of the delay profile (see independent claim 1).

Applicant's claimed invention also provides power consumption control methods comprising unique combinations of method steps including, *inter alia*:

comparing a largest correlation value of the delay profile with a predetermined threshold and stopping operation of the delay profile circuit on the basis of the comparison result (see independent claims 19, 22 and 23)

The Examiner acknowledges that "Shoji did not specifically said [sic] delay profile circuits being stopped, as claimed in claim [sic] 1, 19, 22 and 23" (see Office Action, page 5). In fact, Shoji, which provides "a receiver of a CDMA system utilizing a spread spectrum scheme and, particularly, a receiver which realizes a reliable RAKE synthesis by stably extracting a path timing to be synthesized" (Id., col. 2, lines 41-44), does not disclose, teach or suggest that the operation of any of the delay circuits is stopped, let alone stopped in accordance with a

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correlation value of the delay profile, as recited in Applicant's independent claims 1, 19, 22 and 23.

Neither Popovic, nor Terashima, supply this acknowledged deficiency of Shoji.

Therefore, Applicant's independent claims 1, 19, 22 and 23, as well as their respective dependent claims 2, 3, 9, 11, 13, 20 and 21 (which incorporate all the novel and unobvious features of their base claims) would not have been obvious from Shoji applied alone, or in any reasonable combination with Popovic or Terashima, at least for these reasons.

The Examiner's alleges that "it would have been obvious to a person of ordinary skill in the art at the time of the invention that in the Shoji reference the delay values are changed in response to a correlation value" (see Office Action, page 5). However, this conclusion does not provide any rational as to how Shoji allegedly teaches or suggests stopping operation of its delay circuits as recited in Applicant's claims 1, 19, 22 and 23.

In this regard, Applicant respectfully submits that the Examiner's conclusion, and its application to the requirements set forth in Applicant's claims 1, 19, 22 and 23, finds no basis in either the cited prior art, or the general knowledge of artisans skilled in the art of radio telecommunication. Accordingly, the Examiner is respectfully requested either to provide evidence to support the conclusory statements as to the alleged common knowledge in the art of radio telecommunication, or to withdraw the obviousness rejections. In this regard, the Examiner is directed to MPEP 2144.03 which states, *inter alia*, "[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal

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evidence upon which a rejection was based” (MPEP 2144.03(E)). *See also*, MPEP also states at §2143 that the “fact that references can be . . . modified is not sufficient to establish *prima facie* obviousness” (emphasis added). Similarly, the same MPEP section emphasizes that the “fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness.” *Id.*

Thus, in addition to traversing the Examiner’s rejections based on the deficiencies of the actual disclosure of the cited prior art references, Applicant respectfully submits that the Examiner has failed to formulate a *prima facie* case of obviousness in that the Examiner failed to present any factual basis to support the alleged “common knowledge” which forms the primary basis of the Examiner’s rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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